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 Request withdrawn
 of restriction
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PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: François GIRARD et al.)	
)	Group Art Unit 3728
Appln. No.	: 09/994,783)	
)	Examiner Anthony Stashick
Docket No.	: P21643)	
)	Confirmation No. 8368
Customer No.	: 7055)	
)	
Filed	: November 28, 2001)	
)	
Title	: SOLE FOR A BOOT, IN PARTICULAR)	
	A SPORTS BOOT, A METHOD OF)	
	MANUFACTURING SAME, AND)	
	A BOOT HAVING SUCH SOLE)	

PETITION FROM RESTRICTION REQUIREMENT
UNDER 37 CFR §1.144

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Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

For reasons presented below, Applicants herewith request that the final requirement for petition, included in the Office action dated August 28, 2003, be modified.

More specifically, Applicants request that the restriction requirement be reconsidered and modified as explained by Applicants in their traverse and request for reconsideration, filed on June 16, 2003 in accordance with the provisions of 37 CFR §1.143.

I. Statement of Facts

A. In an Office action dated May 14, 2003, a requirement for restriction under 35 USC §121 was issued, requiring that Applicants elect one of six inventions, identified in the restriction

requirement as inventions I through VI. Applicants are herein requesting modification of the requirement only with regard to inventions I, II, and III. Inventions I, II, and III are identified in the restriction requirement as follows (see page 2 of the Office action of May 14, 2003):

- I. Claims 1-7, 11, 14-18 (*sic*, "14-17"; see correction on page 2 of Office action of August 28, 2003), 20-24, 31, 34-35, [39] drawn to a sole made into a front half and a rear half with the front half more rigid than the rear half, the front half and rear half attached at a junction point, the sole containing a reinforcement member, classified in class 36, subclass 107.
- II. Claims 8-10 and 19, drawn to a segmented sole with reinforcing member the sole having an attachment for gliding means, classified in class 36, subclass 115.
- III. Claims 12-13 [*sic*, "12, 13, 18"; see correction on page 2 of Office action of August 28, 2003], drawn to a shoe sole made of multiple parts with a reinforcing member, the multiple parts made by duplicate molding, classified in class 36, subclass 31.

B. The restriction requirement alleges that the aforementioned inventions are patentably distinct, apparently as provided for in the Manual of Patent Examiner Procedure (MPEP), Section 808.02 (*i.e.*, rather than "independent", as provided for in MPEP 808.01). Among the reasons given are the following (see page 3 of the Office action of May 14, 2003):

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as using it in any shoe without attaching it to gliding attachment means. See MPEP §806.05(d).
3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instant case the different inventions Inventions I and III are made by different methods and cannot be used together. They function differently as the materials for the parts are made differently.

C. In their reply to the restriction requirement on June 16, 2003, and although provisionally electing the "invention I", Applicants requested reconsideration and modification of the restriction requirement, pursuant to the provisions of 37 CFR §1.143. More specifically, Applicants requested that the restriction requirement be reconsidered and withdrawn at least with regard to the restriction of inventions II and III from elected Invention I. Thereby, Applicants requested (and gave reasons therefor in accordance with §1.143) that claims 8-13 and 19 (which would otherwise be withdrawn as being directed to non-elected inventions II and III), be examined with the claims of elected invention I.

D. In the Office action dated August 28, 2003, Applicants' request for reconsideration was denied and the restriction requirement was made final. Claims 8-13, 18, and 19, *inter alia*, were withdrawn from consideration as being directed to non-elected inventions.

E. As an aside, not directly related to matters addressed in this petition, in Applicants reply to the restriction requirement, they noted that, in accordance with the guidelines in MPEP §821.04, entitled "Rejoinder," upon the allowance of "product claim(s)" (*i.e.*, an independent claim of the elected invention) claims depending upon such product claim(s) that are directed to the method of making and the method of using the product would also be allowed.

II. Points to be Reviewed

A. Whether the claims directed to non-elected inventions II and III should be examined as to their merits with the claims of invention I.

B. Encompassed within point A, whether inventions I and II have been properly identified in the restriction requirement as "subcombinations disclosed as usable together in a single combination", and whether inventions I and III have been properly identified as "unrelated".

III. Action Requested

Applicants request that the restriction, at least with regard to inventions I, II, and III, be withdrawn and that claims directed to all three inventions (presently, claims 1-24, 31, 34, 35, and 39) be examined as to their merits. More specifically, Applicants request that claims directed to non-elected inventions II and III be examined with the claims of the elected invention I.

IV. Arguments in Support of Requested Action

A. Inventions I and II are Not Subcombinations Usable Together in a Single Combination

In MPEP §803 two criteria are given for a proper requirement for restriction between patentably distinct inventions, viz., (1) the inventions must be independent or distinct (see MPEP §802.01) and (2) there must be a serious burden on the examiner if restriction is to be required.

In MPEP §802.01, the term "distinct" is defined as describing two or more inventions that are *related* but which are patentable over each other. On the other hand, the term "independent" is defined as describing two or more inventions for which there is no disclosed relationship therebetween, *i.e.*, *unrelated*.

The restriction between inventions I and II is premised upon their being related inventions, but patentably distinct inventions, which are directed to respective "subcombinations" disclosed as usable together in a single "combination". This premise is erroneous.

The restriction fails to identify the combination with which the subject matter of inventions I and II are usable. Applicants have not disclosed inventions I and II as being subcombinations as being usable together. If the restriction requirement is to be maintained, Applicants request that the portion(s) of Applicants' disclosure be identified as supporting the claim that inventions I and II are usable together in a single combination.

Each of inventions I and II is directed to "a sole of a boot". Inventions I and II are not directed to two separate soles that are "usable together", such as being usable in the same boot, for example. Instead, although the restriction requirement does not completely define invention II (quoted above in Section I.A.), invention II includes the "sole made into a front half and a rear half with the front half more rigid than the rear half, the front half and rear half attached at a junction point, the sole containing a reinforcement member", precisely as identified by the examiner in his description of invention I, inasmuch as all of the claims which are identified as encompassed by invention II depend from claim 1.

That is, invention II is related to invention I in a manner similar to the relationship described in MPEP §806.03, which cannot be used to justify restriction. Although MPEP §806.03 refers to claims of an application that define a *single* disclosed embodiment, which vary only in breadth or scope in the claims, and although Applicants have disclosed a plurality of embodiments, it is not the differences among the plurality of embodiments upon which the restriction requirement is based.

Instead, claims 8-10, 18, and 19 (invention II) merely contain additional limitations to define with more specificity the *same* invention of claim 1. That is, claims 8-10 and 19 vary, with regard to claim 1, *e.g.*, in terms of their breadth or scope. For example, regarding the claims of Inventions I and II, the particular invention of claim 1 (*i.e.*, the reinforcing member associated with a two-part sole) is particularly useful in a sports shoe to be connected to a sports apparatus, because that type of shoe benefits from a greater torsional stiffness than a conventional shoe.

Therefore, even if inventions I and II were separately patentable, they are not subcombinations that are usable together in a single combination. If this reason were to be maintained as supposedly justifying the restriction as between inventions I and II, Applicants kindly request a further explanation and, in particular, an identification of the combination in which the respective subcombinations of claim 1 and claims 8-10 and 19 can be used together.

The statement on page 3 of the Office action of May 14, 2003 justifying the restriction between inventions I and II ("invention I has separate utility such as using it in any shoe without attaching it to gliding attachment means") implies that the examiner understands inventions I and II to be two separate species, or a species under a genus, rather than two inventions that can be used together.

In this regard, Applicants kindly direct attention to MPEP §806.05(d), relating to restrictions between subcombinations usable together. Therein, caution is advised in determining whether the claims are indeed a description of related subcombinations usable together or whether the claims are related as independent species under a claimed genus. As explained in MPEP §806.05(d), "[i]f restriction is improper under either practice [*i.e.*, the practice applicable to election of species and the practice applicable to related inventions], it should not be required."

Certainly, under the practice applicable to election of species, restriction between claim 1 and claims 8-10 and 19 should not be required.

Further, inasmuch as claims 8-10 and 19 depend from claim 1 (directly or indirectly), they already *include* the limitations of parent claim 1 by virtue of their dependent relationship with claim 1. Thus, the restriction between inventions I and II are the AB_{sp}/B_{sp} variety, where B_{sp} is represented by claim 1. Therefore, according to MPEP §806.05(c), Example II, restriction is not proper.

At least for the foregoing reasons, reconsideration and withdrawal of the restriction between inventions I and II is kindly requested.

B. Inventions I and III are Not Unrelated

As mentioned above, in the Office action of May 14, 2003, the restriction between inventions I and III is based upon the position that inventions I and III are *unrelated*. That position is erroneous.

If inventions I and III are unrelated, then, according to the MPEP, they are *independent*. See MPEP §802.01 and §806.04, the latter being cited in the Office action in the justification for the restriction between inventions I and III.

Further, if the restriction requirement between inventions I and III is to be maintained, Applicants kindly request an explanation regarding how they have "different modes of operation, different functions, or different effects", or how they "function differently as the materials for the parts are made differently", as advanced in the Office action requiring this restriction.

In fact, there is nothing specified in claim 1 (invention I), for example, that is inconsistent with that of claims 12, 13, and 18 (invention III). That is, invention I, as specified in claim 1 (a broader recitation of invention III), includes nothing regarding a different function or materials which would make it unsuited for invention III. Invention I, as specified in claim 1, includes nothing regarding different manufacturing methods which would make it unsuited for invention III.

Instead, claims 12, 13, and 18 (invention III) merely contain additional limitations to define the *same* invention of claim 1 in greater specificity. That is, claims 12, 13, and 18 vary, with regard to claim 1, *e.g.*, in terms of their breadth or scope.

Further, inasmuch as claims 12, 13, and 18 depend from claim 1 (directly or indirectly), they already *include* the limitations of parent claim 1 by virtue of their dependent relationship with claim 1. Thus, the restriction between inventions I and III are the AB_{sp}/B_{sp} variety, where B_{sp} is represented by claim 1. Therefore, according to MPEP §806.05(c), Example II, restriction is not proper.

At least for the foregoing reasons, reconsideration and withdrawal of the restriction between inventions I and III is kindly requested.

C. No Serious Burden in Examining Claims to Inventions II and III

As mentioned above, even if it were to be found that the inventions of I, II, and III are independent or patentably distinct, a proper requirement for restriction requires there be a serious burden on the examiner.

It is explained in MPEP §803 that a serious burden can be *prima facie* shown if an appropriate explanation were to be made of a separate classification, or separate status in the art, or a different field of search.

Each of the claims directed to non-elected inventions II and III (*i.e.*, claims 8-10, 12, 13, and 19) *depends from claim 1*, directly or indirectly. Therefore, each of the claims directed to non-elected inventions II and III includes all the limitations of claim 1.

Therefore, despite the identification of the classification of invention I as in class 36, subclass 107, the latter being indented under "Boots and Shoes" (subclass 83) and including a shoe or boot "having shoe-reinforcing plate", invention II *also includes the shoe-reinforcing plate of invention I*, inasmuch as the claims of invention II depend from claim 1 of invention I.

Similarly, invention III *also includes the shoe-reinforcing plate of invention I*, inasmuch as the claims of invention III also depend from claim 1 of invention I.

Therefore, Applicants submit that the showing of a separate classification and a separate status in the art for the three inventions is not a compelling justification for restricting between inventions I and II and between inventions I and III.

Invention II is identified as being classified in class 36, subclass 115, *i.e.*, a boot or shoe "for a sport." Because the claims of invention II depend from claim 1 (of invention I), does this different classification from that of invention I demonstrate recognition of the following as two subjects (describing the apparent differences in class 36, subclass 107, and class 36, subclass 115, the latter as it pertains to Applicants' invention having an attribute of subclass 107) as being

sufficiently separate as justifying restriction: (1) a boot having a shoe-reinforcing plate and (2) a sports boot having a shoe-reinforcing plate? Further, would the searches for the two inventions be significantly different?

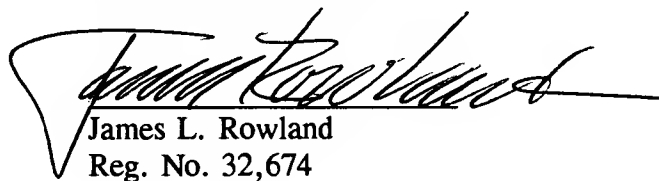
V. Summary

For the reasons given above, Applicants request that the restriction, at least with regard to inventions I, II, and III, be withdrawn and that claims directed to all three inventions be examined as to their merits.

No fee is believed necessary. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and/or complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to Applicants' undersigned attorney at the telephone number given below.

Respectfully submitted,
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